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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,505	03/08/2001	Seigo Kotani	1405.1036	2180
21171 7590 04/24/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SIMITOSKI, MICHAEL J	
			ART UNIT 2134	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/24/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/800,505	Applicant(s) KOTANI ET AL.	
	Examiner Michael J. Simitoski	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7 and 9-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10,11,15,16,18,22,23,27 and 28 is/are rejected.
- 7) ☒ Claim(s) 5,7,9,10,12-14,17,19-21 and 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 2/16/2007 was received and considered.
2. Claims 1, 5-7 & 9-28 are pending.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 5-7 & 9-28 have been considered but are moot in view of the new ground(s) of rejection.

It is noted that Applicant has neither responded to nor amended in response to the rejection of claim 15 under 35 U.S.C. §112 ¶2. Therefore, this rejection is repeated.

Claim Objections

4. Claims 5 & 10 are objected to because of the following informalities:

Regarding claim 5, the claim should depend from claim 1.

Regarding claim 10, the limitation "apparatus-specific" should be replaced with "apparatus-specific information specific to an apparatus that drives said recording medium" to maintain consistency with the other claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 18-26 & 28 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. Regarding claim 18, the limitation “an information management apparatus having medium-specific information and comprising a user-use area allowing ...” is not described in the specification; the specification describes an information management apparatus that uses a medium having medium-specific information, a user-use area, etc.”

Claims 19-26 & 28 are rejected based on their dependence upon claim 18.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 10, 15-16, 22 & 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

b. Regarding claim 5, the limitation “said second area” (last line) lacks sufficient antecedent basis.

c. Regarding claim 10, the limitation “said license information encrypted and stored in said user-use area” lacks sufficient antecedent basis because storing the encrypted license information in the user-use area is recited in the alternative in the depending claim.

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- d. Regarding claim 15, the limitation “can be electronically obtained” (line 2) is unclear because whether the medium-specific information is obtained electronically or not is unclear.
- e. Regarding claim 16, the limitation “said apparatus-specific information” (line 2) lacks sufficient antecedent basis.
- f. Regarding claim 22, the limitation “said license information encrypted and stored in said user-use area” lacks sufficient antecedent basis because storing the encrypted license information in the user-use area is recited in the alternative in the depending claim.
- g. Regarding claim 27, the limitation “the second area” lacks sufficient antecedent basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 5-6, 11, 18, 23 & 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2002/0016919 to Sims, III (**Sims**).

Regarding claims 1 & 27, Sims discloses an information management method managing information of a recording medium (disk, Fig. 1, #100) by an information management apparatus

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(disk reader), the recording medium having medium-specific information (media public key, ¶95) and comprising a user-use area (unprotected area 102) allowing writing and read out of arbitrary information in accordance with external instructions (¶33) and a secure area (protected storage area 101) that is not subject to control by external instructions (¶33 & ¶40), said information management apparatus having a write and read out means (player 150/content provider, ¶38, ¶95 & Fig. 1) writing the arbitrary information to and reading the arbitrary information from said user-use area (¶89) and a predetermined information deriving means deriving the predetermined information (disk key, ¶95) stored in the secure area (¶85), comprising storing an encrypted electronic data (content) to the user-use area of the recording medium as the arbitrary information (¶86 & ¶89), storing license information based on use rights for using the encrypted electronic data stored in the user-use area (disk key, ¶81) to the secure area of the recording medium as the predetermined information (¶85), deriving (extracting) the license information (disk key) outside said secure area of the recording medium (by media device) and encrypting the license information stored in the secure area using medium-specific information (encrypt with media public key, ¶97) or a key generated therefrom (acceptable user's public key, ¶97; the medium-specific disk key is used, in conjunction with the clearing house/provider to generate the acceptable user key, which is then used to encrypt the disk key, ¶95), and storing the encrypted license information (disk key) to the user-use area or other recording medium (stored at the provider for use, ¶95).

Regarding claim 5, Sims discloses wherein said license information (disk key) is encrypted using said medium-specific information (public key, ¶95) or said key generated therefrom (¶97) and is stored in a medium (¶95).

Regarding claim 6, Sims discloses wherein said license information (disk key) is encrypted (§97) using information specific to an apparatus that drives said recording medium or a key generated therefrom (media public key, §95 & §97).

Regarding claim 11, Sims discloses wherein said license information is encrypted (encrypted content/disk key) and stored on a second recording medium (play-back device, §97 or clearing house, §95) different from said recording medium.

Regarding claims 18 & 28, Sims discloses an information management apparatus (media player 120 and media device 110, called player (§38 & Fig. 1)) having medium-specific information (public key of acceptable user, §97) and comprising a user-use area (unprotected area 102, §33) allowing writing and reading out of arbitrary information in accordance with external instructions (§34) and a secure area 101 that is not subject to control by external instructions (§33; see also Fig. 1), said information management apparatus managing information (disk key) of a recording medium wherein license information based on use rights (disk key) for said arbitrary information (content) stored in said user-use area is stored in said secure area (secure area 101, §33, §40 & §85), said information management apparatus (player 150/content provider, §38 & Fig. 1) comprising write and read out means (media device 110/content provider, Fig. 1 & §34) writing said arbitrary information to and reading said arbitrary information from said user-use area (area 102, Fig. 1 & §34) and predetermined information deriving means (media device 110 and media player 120, Fig. 1) encrypting said license information (content key/disk key, §97) stored in a secure area (area 101, Fig. 1 & §97) using said medium-specific information or a key generated therefrom (public key of acceptable users, §97), deriving (extracting) said encrypted license information (content key/disk key, §97) outside

said secure area (in play-back device) and storing the encrypted license information in the user-use area of the recording medium or another recording medium (provider, ¶97).

Regarding claim 23, Sims discloses wherein said predetermined information deriving means (media device) transmits said encrypted license information (encrypted content key to a second recording medium different from said recording medium (provider, ¶97).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 15, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over **Sims**, as applied to claim 1 above, in further view of U.S. Patent 5,191,611 to **Lang**.

Regarding claim 15, Sims, as modified above, lacks the medium-specific information (key) being visually displayed on the recording medium. However, Lang teaches that by displaying information visually on a device for controlling access to data, a user can manually enter the data into another device (col. 6 lines 55-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sims to visually display the medium-specific information (media public key or apparatus key) on the disk. One of ordinary skill in the art would have been motivated to perform such a modification to allow for manual entry of the public media key or apparatus key into a device, as taught by Lang (col. 6 lines 55-59).

Allowable Subject Matter

13. Claims 7, 9-10, 12-14, 17, 19-22 & 24-26 are believed to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

h. Regarding claim 7, the prior art relied upon fails to teach or suggest encrypting and storing license information to the user-use area, decrypting the encrypted license information using the medium-specific information or a key generated therefrom, and updating the license information stored in said secure area, in combination with the other elements of the claim. Claim 9 is indicated allowable based on its depending from claim 7.

i. Regarding claim 12, the prior art relied upon fails to teach or suggest encrypting said license information that is stored in a secure area of a medium, storing the encrypted license information on a second recording medium, decrypting the encrypted license information using medium-specific information or a key generated therefrom and updating the license information in the secure area, in combination with the other limitations of the claim.

j. Regarding claim 13, the prior art relied upon fails to teach or suggest when said license information is to be derived on said second recording medium, it is encrypted using said medium-specific information or a key generated therefrom and apparatus-specific information specific to an apparatus that drives said second recording medium or

a key generated therefrom, in combination with the other limitations of the claim. Claims 14 & 17 are indicated allowable based on their depending from claim 13.

k. Regarding claim 19, the prior art relied upon fails to teach or suggest storing encrypted license information by the write and read out means in said user-use area, in combination with the other limitations of the claim. Claim 20 is indicated allowable based on its depending from claim 19.

l. Regarding claim 21, the prior art relied upon fails to teach or suggest the apparatus comprising apparatus-specific information, wherein said predetermined information deriving means encrypts said license information using said medium-specific information or said key generated therefrom and apparatus-specific information specific to said apparatus or a key generated therefrom, in combination with the other limitations of the claim. Claim 22 is indicated allowable based on its depending from claim 21.

m. Regarding claim 24, the prior art relied upon fails to teach or suggest predetermined information updated means decrypting said license information encrypted and stored in said second recording medium using said medium-specific information and updating license information stored in said secure area, in combination with the other limitations of the claim.

n. Regarding claim 25, the prior art relied upon fails to teach or suggest wherein an apparatus that drives said second recording medium comprises apparatus-specific information specific to an apparatus that drives said second medium and said predetermined information deriving means encrypts said license information using said medium-specific information or said key generated therefrom and apparatus-specific

information specific to an apparatus that drives said second recording medium or a key generated therefrom, in combination with the other elements of the claim. Claim 26 is indicated allowable based on its depending from claim 25.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS



April 12, 2007



KAMBIZ ZAND
SUPERVISORY PATENT EXAMINER